PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eric J. Hansen and Jesse J. Williams	
For:	EXTRACTION CLEANING WITH OXIDIZING AGENT	
Serial No.:	09/589,973	Examiner: Necholus Ogden Jr.
Filed:	06/08/00	Group Art Unit: 1751
Atty. Docket:	71189-1300	Confirmation No: 9893

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Sir:

APPLICANT'S REASONS IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW OF FINAL REJECTION

This paper is filed in support of Applicants Request for a Pre-Appeal Brief Conference in accordance with 1296 Off. Gaz. Pat. Office 67 (12 July 2005) entitled: "New Pre-Appeal Conference Pilot Program." (Extended January 10, 2006.) Applicants believe that the rejections of record are not proper and are without basis in fact or law. This request is based on clear legal and/or factual deficiencies in the rejections and not based on interpretation of claims or prior art teachings. In particular, the rejection of claim 21 and dependent claims 2-10, 12-16, 19, 20 and 22-28 is contrary to the decision of the Board of Patent Appeals and Interferences (BPAI) Mailed August 17, 2005) in this matter and is not supported in fact by the record. Further, the

Examiner has not made a *prima facie* case of unpatentability of claim 18 under 35 U.S.C. § 103 as required by *In re Vaeck* 947 F.2d 488, 20 USPQ 2nd 1438 (Fed. Cir. 1991).

The Examiner has not made a prima facia case of unpatentability of claim 18.

Claim 18, one of the two independent claims on appeal, reads as follows:

> 18. (Currently amended) A method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction, comprising the steps of:
>
> admixing an oxidizing agent with the cleaning solution prior to the step of dispensing the cleaning solution onto the upholstery or carpet surface;
>
> mixing the admixture with heated air to heat the admixture; and
>
> heating the air before the step of mixing with admixture with heated air.

See Amendment under 37 CFR § 1.197 filed October 13, 2005. The BPAI, in reversing the Examiner's rejection of this claim, in a footnote invited "the Examiner and the Appellants should consider and resolve whether the claims under consideration patentably distinguished over the combined teachings of Miracle [US patent 5, 576, 282] and McAllise et al. patent [McAllise et al. 5.500,977] (e.g. see Figures 8b and 11a, the paragraph bridging columns 8 and 9 as well as lines 11-26 in column 12)." (BPAI Opinion at page 7). Subsequent to the BPAI decision, the examiner rejected claim 18 over the combination of Miracle et al. '282 and Perkins '968 in further combination with McAllise et al. '977.[1] (Office Action mailed January 9, 2006) and subsequently made final (Office Action mailed June 12, 2006) after a Response filed by Applicants. Applicants appealed this final rejection and requested a Pre-Appeal Brief Conference on September 12, 2006. In its decision dated October 23, 2006, the Conference Panel withdrew the final rejections and reopened prosecution.

Claim 18 has now been finally rejected under 35 U.S.C. 103 (a) as being unpatentable over McAllise et al. '977 in view of Miracle et al. '282. This rejection of claim 18 is not materially different than the previous final rejection that the Conference Panel withdrew. The

1 It is significant that the BPAI could have but did not reject claim 18 over the combination of Miracle et al. '282 and McAllise et al. '977 but chose not to do so. Rather, the BPAI suggested that the Examiner give consideration as to whether or not claim 18 patentably distinguished over the combined teaching of Miracle et al. '282 and McAllise et al '977.

arguments supporting reversal of this rejection are not appreciably different than arguments made in the previous request for a Pre-Appeal Brief Conference. Applicants' arguments in support of reversal of the Examiner's current final rejection are set forth in Applicants' Response to the Office Action mailed July 26, 2007, filed October 24, 2007, pages 2-3, incorporating Applicants' discussion of McAllise et al. '977 on pages 2 and 3 of Applicants' Response to the Office Action filed on April 4, 2006. In particular, neither McAllise et al. '977 nor Miracle et al. '282 disclose the claimed steps of heating air prior to the step of mixing the cleaning solution/oxidizing agent admixture with heated air to heat the admixture and the step of mixing the admixture with heated air.

The rejection of claim 21 and the claims dependent therefrom is contrary to the decision of the BPAI.

Claim 21, the other independent claim on appeal, as amended following the decision by the BAPI reads as follows:

> 21. (Currently amended) A method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction, comprising the steps of:
>
> admixing an oxidizing agent with the cleaning solution prior to the step of dispensing the cleaning solution onto the upholstery or carpet surface; and
>
> heating the cleaning solution before the admixing step to heat the admixture.

See Amendment under 37 CFR § 1.197 filed October 13, 2005.

Claim 21 and the claims dependent therefrom have been rejected as unpatentable over the U.S. patent to Wang 5,987,696 (Wang '696) in view of Miracle et al. U.S. Patent No. 5,576,282 (Miracle et al. '282). The Wang '696 reference and Applicants' response to the rejection of these claims over Wang '696 in view of Miracle et al. '282 is set forth on pages 4-6 of Applicants' Response to Office Action Mailed July 27, 2007 and filed on October 24,2007, which is incorporated herein by reference. Claim 21 and the claims dependent therefrom have been further rejected as unpatentable over McAllise et al. '977 in view of Miracle et al. '282. Applicants' response to the rejection of these claims over McAllise et al. '977 in view of Miracle et al. '282 is discussed on pages 6-7 of Applicants' Response to Office Action Mailed July 27, 2007 and filed on October 24, 2007, which is also incorporated herein by reference.

Claim 21 was the subject of a first Appeal to the BPAI. It depended from claim 1 and added the limitation of "heating the cleaning solution before the admixing step to heat the admixture" as shown above. The Examiner had rejected these claims over Miracle et al.'282 in view of the Ligman U.S. Patent No. 5,555,595 (Ligman '595) or Sham U.S. Patent No. 5,386,612 (Sham '612). In its decision of August 17, 2005, the BPAI held that the Miracle et al. '282 patent was properly combined with Sham '612 or with Ligman '595 as a prior art teaching of incorporating the Miracle oxidizing composition in either the Sham '612 or the Ligman '595 extraction cleaners to meet the limitations of claim 1. BPAI Opinion, p 3-5. Applicants do not dispute this holding of the BPAI.

Wang '696 and McAllise et al. '977 disclose nothing more with respect to the subject matter of claim 21 than the Perkins '986 reference cited in the previous final rejection or Ligman '595 or Sham '612 that the Examiner cited in his first final rejection that was reversed by the BAPI. Thus, the Examiner's combination of Wang '696 or McAllise et al. '977 and Miracle et al. '282 is no different than the Examiner's flawed combination of Perkins '968 and Miracle et al. '282, which was reversed by the Panel Decision from Pre-Appeal Brief Conference, and further is no different than the Examiner's combination of Ligman '595 or Sham '612 and Miracle et al. '282, which was reversed by the BAPI. The Examiner continues to ignore the BAPI decision which is the law of the case. Merely recasting the same old rejection is different cloth does not change the nature of the flawed reasoning. The Examiner should be directed to follow the Rules of the Patent Office and the law of the case and cease making the same rejections that have been reversed by BAPI.

The Wang '696 and McAllise et al. '977 references disclose nothing more than what is disclosed in the Sham '612 or the Ligman '595 references with respect to the claimed invention of claim 21. The Examiner has not articulated any differences between the Wang '696 or McAllise et al. '977 references and either of the Sham '612 or the Ligman '595 references. Therefore, Applicants believe that the decision of the BPAI with respect to the claims in this application controls and is the law of the case.

Claim 18 has also been rejected over Wang '696 or McAllise et al. '977 in view of Miracle et al. '282 in same rejections of claim 21 over these combinations as discussed above

but the Examiner has made no analysis of either of these combinations with respect to claim 18. The Examiner has thus given not reasons for the rejection of claim 18 over these two combination of references. In any case, either alleged combination does not disclose the claimed steps of heating air prior to the step of mixing the cleaning solution/oxidizing agent admixture with heated air to heat the admixture and the step of mixing the admixture with heated air.

Conclusion

The rejections made by the Examiner in his final rejection of the claims are not supportable in law or fact as set forth above. Reversal of the Examiner's rejection and allowance of the claims are respectfully requested.

Respectfully submitted,

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Dated: April 4, 2008

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